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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,640	03/06/2002	Kazuo Asami	H6810.0042/P042	6070

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EXAMINER	
AHMED, AFFAF	

ART UNIT	PAPER NUMBER
3609	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/090,640	ASAMI ET AL.	
	Examiner	Art Unit	
	Affaf Ahmed	3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 March 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/20/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

Status of Claims

1. This action is in reply to the Application filled on 03/06/2002.

2. Of the original claims 1-22 filed on 03/06/2002, claim 4 have been amended and claims 1-22 has been filed on 4/27/2004

3. Claims 1-22 are currently pending and have been examined.

Information Disclosure Statement

4. The Information Disclosure Statement filed on 06/20/2005 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Inventorship

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 4, items HDg and HDf. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "4" and "1" have both been used to designate Public Line of fig 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 7, item 20. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application.

Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

9. The abstract of the disclosure is objected to because of the use of legal phraseology. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

10. The disclosure is objected to because of the use of "appended claims". Uses of such words are objected to because submission of an amendment of the claims may result on having a different scope to the claims. Appropriate correction is required.

11. The disclosure is objected to because of the following informalities: abbreviation of "Internet I" is not shown in the drawings. Appropriate correction is required.

Claim Rejections-35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13 Claims 1 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

14 Claims 1,12 are directed to storing, transmitting and receiving data without providing for how the data is used to achieve a "useful, concrete and *tangible result" (State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998)). Claims 1 and 12 are directed to awarding a *privilege*. However, a privilege, given it's broadest reasonable interpretation (In re Zletz) is at least not a tangible. Therefore, claims 1 and 12 are directed to non-statutory subject matter. The terminal of claim 1, however, lacks utility as Applicant has failed to disclose enough information about the claimed terminal to make its usefulness immediately apparent to those familiar with the technological field of the invention (MPEP 2107.01).

Claim Rejections-35 USC § 112

15 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16 Claims 1-4, 6-9,11-15,17,19,20,22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17 Claim 1 recites the limitation "*wherein apparatus estimates a value of the information*". For purpose of examination, it was assumed that "apparatus" was intended to be an information providing business for providing information.

18 Further more claims 1-4, 6-9,11-15,17,19,20,22 recite the limitation "*transmitting a provision medium over communications network*". However, to one of ordinary skill a "medium" is a physical object (e.g. Internet, DVD, flash memory) and cannot be transmitted. Therefore, the scope and operation of Applicant's claimed method, system, and device, is not clear to one of ordinary skill (In re Zletz,13 USPQ2d 1320 (Fed. Cir. 1989)).

19 Claim 6 recites the limitation "*publicizing the information of the information provider using a provision medium capable of*". However, it has been that actions that may or may not be done are indefinite and does not distinguish the claim from the prior art (In re Collier, 158 USPQ 266 (CCPA 1968)), therefore

claim 6 is rejected under 112 second paragraph. Further more, claim 8 recites "the privilege is a prize money obtainable from advertising rate".

20 Claims 7-11 are also rejected as each depends from claim 6.

21 Claim 17 recites the limitation "*publicizing the information of the information provider using a provision medium capable of*". However, it has been that actions that may or may not be done are indefinite and does not distinguish the claim from the prior art (In re Collier, 158 USPQ 266 (CCPA 1968)), therefore claim 6 is rejected under 112 second paragraph.

22 Claims 18-22 are also rejected as each depends from claim 17.

23 The term "relatively high" in claims 6 and 17 is a relative term, which renders the claim indefinite. The term "relatively high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

24 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25 Claims 1, 6, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl et al. (US 2002/0107858 A1) in view of Mankovitz (US 5,703,795 A).

Claims 1, 6, 12, and 17:

Lundahl, in at least paragraphs 0086, 0107, and 0119 discloses the limitation of *information value estimating means for estimating a value of the information of the information provider based on the number of times the information of the information provider is received at the information receiver terminal by way of the provision medium.* Lundahl does not specifically disclose *privilege awarding means for awarding a privilege to the information provider in accordance with the information value that is estimated by the information value estimating means so as to give the privilege to the information provider if the estimated information value is relatively high.* Mankovitz, however, in at least column 2, lines 31-39 discloses, "Advertising rates for commercials of television programs are determined by the expected size of viewer audience for a predetermined number of television programs. These expectations are usually determined by the estimated audience sizes of previously broadcast shows. For example, for a weekly television

series, the estimate of audience size for upcoming episodes is based on the estimated size of previously broadcast shows. In addition, advertising rates may be adjusted based on an "after the fact" estimation of the market share for the televised program." Mankovitz does not explicitly disclose that payment is made to the information provider by the advertising rate income. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lundahl's information value estimation technique with Mankovitz's method of paying for information by selling advertising space because, as shown by Mankovitz, the size of a viewing audience determines the value of the advertising rate, and in turn, the value of the information viewed.

26 Claims ***2, 8, 13, and 19*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl et al. (US 2002/0107858 A1) in view of Mankovitz (US 5,703,795 A).

Claims 2, 8, 13, and 19:

Lundahl does not specifically disclose *the privilege that is at least a part or whole of an advertising rate of an advertisement placed in the provision medium; the privilege is prize money obtainable from the advertising rate of the advertisement placed on the provision medium and/or a communication charge refund obtainable from a part of a communication charge of the communication medium*; however Lundahl discloses in paragraph 0107 that " data analyzed could again be related to Internet-based advertising, the various data matrices including: numerical measures of the outcomes of a web-viewing event; common measures of qualities of a web page viewer; and common measures of the content displayed on a web page." Mankovitz, however, in at least column 2, lines 31-39 discloses, "Advertising rates for commercials of television programs are determined by the expected size of viewer audience for a predetermined number of television programs. These expectations are usually determined by the estimated audience sizes of

previously broadcast shows. For example, for a weekly television series, the estimate of audience size for upcoming episodes is based on the estimated size of previously broadcast shows. In addition, advertising rates may be adjusted based on an "after the fact" estimation of the market share for the televised program." However, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lundahl's data analysis technique using Internet and web-viewing event with Mankovitz's method of paying for information by selling advertising space because, as shown by Mankovitz, the size of a viewing audience determines the value of the advertising rate, and in turn, the value of the information viewed.

27 Claims 3, 4, 5, 7, 11, 14, 15, 16, 18, and 22 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl/Mankovitz and further in view of Hong (US 2002/0062372 A1).

Claims 3, 4, 5, 7, 11, 14, 15, 16, 18, and 22:

With regard to the limitations of:

- *the provision medium is transmitted through a communication medium;*
- *the provision medium is a web page publicized on the Internet*;

See at least Lundahl, paragraphs 0107.

The combination of Lundahl/Mankovitz discloses the limitations as shown in the rejections above. Lundahl/Mankovitz do not disclose:

- *the number of accesses to the web page is displayed thereon;*
- *the apparatus estimates the value of information based on the number of accesses to the web page;*
- *a database for setting number of times the information of the information provider is received at the information receiver terminal by way of the provision medium, wherein*

the information value estimating means estimates the value of the information of the information provider based on the database;

Hong, however, in at least paragraph 0073 discloses a web page hit counter and its "hotness." It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lundahl/Mankovitz with Hong because tracking the amount of hits a web page gets is an excellent indicator of the value of then information contained on the website.

The combination of Lundahl/Mankovitz/Hong does not specifically disclose a database for storing hit counts. However, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lundahl/Mankovitz/Hong because database functionality is an efficient technique for saving and retrieving data.

28 Claims **9, 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl et al. (US 2002/0107858 A1)

Claims 9 and 20:

With regard to the limitations of:

- *the provision medium is provided with a questionnaire column for the information receiver to write in usefulness of information, and*
- *the information value estimating means adds the usefulness written in the questionnaire column to a value of the information of the information provider to estimate the value,*

See at least Lundahl, paragraph 0110.

29 Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundahl/Mankovitz/ Hong and further in view of Meyer (6915271)

Claims 10 and 21:

The combination of Lundahl/Mankovitz/Hong discloses the limitations as shown in the rejections above. Lundahl/Mankovitz/Hong do not disclose:

- *the information value estimating means converts the value of the information into points and calculates the points at a predetermined interval, and the privilege awarding means awards the privilege based on the calculated points*

Meyer, however in at least column 3, lines 1-13 calculating points and redeeming awards. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lundahl/Mankovitz/Hong with Meyer because calculation of points is an efficient method to redeem awards electronically.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday- Friday 7:30 AM- 5:00 PM EST, ALT Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Reagan can be reached on 571-272-6710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Name : Affaf Ahmed

Title : Patent Examiner

Date : 5/06/2007

Signature:

JAMES REAGAN
SUPERVISORY PATENT EXAMINER